

REMARKS

The Examiner is thanked for the thorough examination of this application and the indication that claims 3-6 contain allowable subject matter. The Office Action, however, rejected claims 1, 2, 8-11, and 13 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Mai (U.S. patent 6,871,979) in view of Evanicky et al. (U.S. patent 6,144,360). Applicant respectfully requests reconsideration of the rejections in view of the following comments.

Independent claim 1 recites:

1. A direct backlight module comprising:
a first plate;
a second plate connected to the first plate forming a space between;
a plurality of light sources disposed in the space; and
a third plate with a plurality of openings disposed outside the space, the third plate directly and conformally contacting the first plate along a substantial portion of the third plate and the first plate.

(*Emphasis added.*) Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

As disclosed in the present application, heat from the lamp 240 is radiated to the reflecting plate 250, conducted via the reflecting plate 250 and dissipated to the air outside the back light module by convention. In Mai, however, heat from lamp 44 is dissipated by convention. The air inside the backlight module flows through the slit 56 and the hole 58 to outer environment. In Mai, as heat convection is the main heat dissipation mechanism, air-flow through the slit 56 and hole 58 is necessary. Therefore, the arc-shaped structure 50a, the reflecting sheet 50 and the housing 52 must have different levels. In Mai, the distance/separation between the arc-shaped structure 50a, the reflecting sheet 50, and the housing 52 is necessary to ensure proper heat dissipation.

In Evanicky, however, there is no distance or separation between the plastic case 45 and reflective plate 42.

Applicant submits that there is no proper motivation to combine Mai and Evaniky. Indeed, in view of the divergent teachings of Mai and Evaniky, Applicant submits the two references teach away from the alleged combination. In this regard, the combination of the Mai and Evaniky would result in a structure that would not achieve the heat dissipation function of the structure of the claimed embodiments. *"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.* In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." The rejection under 35 USC 103 is overcome.

The Office Action alleged that the combination of Mai and Evaniky would have been obvious "in order to reflect more light back into the second plate." (Office Action, p. 2) Applicant respectfully disagrees for at least the reason that the combination would in a structure that nullify the desired heat dissipation properties of the structure of the claimed embodiments. Further, this alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must

be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a direct backlight module structure, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

For at least these reasons, Applicant requests that the rejection of claim 1 be withdrawn. The rejections of claims 2, 8-11 and 13 should be withdrawn for at least the same reason as claim 1.

No fee is believed to be due in connection with this Response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By:



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